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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/783,011	02/23/2004	R. Lee Miller	21154.022	7482

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EXAMINER

BLAU, STEPHEN LUTHER

ART UNIT

PAPER NUMBER

3711

DATE MAILED: 11/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/783,011

Applicant(s)

MILLER, R. LEE

Examiner

Stephen L. Blau

Art Unit

3711

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 23 February 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-8 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-8 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### ***Specification***

1. The disclosure is objected to because of the following informalities: On page 7 line 12 the statement "shaft cap end 25" does not make sense. There is no cap at 25.

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 112***

2. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

3. Claims 2 and 7 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claims 2 and 7 have first diameter having a lesser diameter than the second diameter yet the claim these claims depend on has the diameter progressively decreasing from a first diameter to a second diameter.

The first diameter should have the largest value.

***Claim Rejections - 35 USC § 103***

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 1, 4-6 and 8 are rejected under 35 U.S.C. 103(a) as being unpatentable over 2001-46568 in view of Miyasu.

2001-46568 lacks a grip having an external surface substantially circular cross-sectional configuration through out the length of a body, an alignment means extending upwardly from an exterior surface of a body from a shaft end to a cap end and an alignment means being an elongated ridge in alignment with a longitudinal axis of a body. Miyasu (Figs. 1, 4, Abstract, [0015]) discloses an alignment means extending upwardly from an exterior surface of a body from a shaft end to a cap end, an alignment means being an elongated ridge in alignment with a longitudinal axis of a body and an external surface being circular. Miyasu does not disclose the external surface being circular throughout the length of a shaft but clearly an artisan designing a grip with a uniform feel would have selected a suitable shape throughout the length in which circular is included. In view of the patents of Miyasu it would have been obvious to modify the grip of 2001-46568 to have an alignment means extending upwardly from an exterior surface of a body from a shaft end to a cap end and an alignment means being an elongated ridge in alignment with a longitudinal axis of a body in order to assist a

Art Unit: 3711

golfer in properly aligning a club at impact. In view of the patents of Miyasu it would have been obvious to modify the grip of 2001-46568 to have a grip having an external surface substantially circular cross-sectional configuration through out the length of a body in order to provide a uniform feel along the length of a shaft by having the shape stay the same.

6. Claims 2-3 and 7 are rejected under 35 U.S.C. 103(a) as being unpatentable over 2001-46568 in view of Miyasu as applied to claims 1, 4-6 and 8 above, and further in view of Hadge.

2001-46568 lacks a grip having a diameter at a shaft end being .92 to .95 inch and a diameter at a cap end being .77-.80 inch. Hadge discloses a reversed tapered grip having a grip having a diameter at a shaft end being .92 to .95 inch and a diameter at a cap end being .77-.80 inch (Col. 3, Lns. 54-59). In view of the patent of Hadge it would have been obvious to modify the grip of 2001-46568 to have a diameter at a shaft end being .92 to .95 inch and a diameter at a cap end being .77-.80 inch. in order to utilize dimensions for reverse tapered grips used in the market place.

### ***Conclusion***

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. Takeuchi and Rosasco disclose grips with ridges.


8. Any inquiry concerning this communication or earlier communications from the

Art Unit: 3711

examiner should be directed to Steve Blau whose telephone number is (571) 272-4406.

The examiner is available Monday through Friday from 8 a.m. to 4:30 p.m.. If the examiner is unavailable you can contact his supervisor Greg Vidovich whose telephone number is (571) 272-4415.

slb/ 14 November 2004



**STEPHEN BLAU**  
**PRIMARY EXAMINER**